

Claims”) are not analogous to those in *In re Doyle* because Applicant’s pending claims are “not broad enough to read on . . . the invention elected (and patented) together with the invention not elected.” See Action at 3. Applicant appreciates the Examiner having reviewed *Ex Parte Okamoto*. According to Examiner *Ex Parte Okamoto* is “irrelevant” because “[t]he was no formal election of species or restriction presented in the Appellant’s original application.” See id. at 7.

Examiner further asserted that the New Claims are not “subcombination claims linking plural inventions.” See id. at 3. The Examiner’s position appears to be based on his conclusion (1) that the specification does not teach the interrelationship between the different embodiments and (2) that the originally elected and non-elected subject matter are mutually exclusive from one another. Finally, the Examiner rejects the New Claims under the written description requirement of 35 U.S.C. § 112 ¶ 1. See id. at 6.

Applicant respectfully disagrees with the Examiner on these four points and traverses them in turn below.

A. The *In re Doyle* Test Applies to Any Linking Claims Rather Than Just Genus Linking Claims

In *In re Doyle*, the applicant filed claims corresponding to several species. See 293 F.3d at 1356. Following a restriction requirement, Doyle elected one species without traverse and failed to pursue the non-elected claims in a divisional application, just as occurred in the present case. See id. During reissue, he did not seek to pursue the non-elected claims. Instead, Doyle sought to claim the genus encompassing the species corresponding to both the elected and non-elected groups. See id. at 1357. The issue was whether the failure to pursue such a genus claim during the original prosecution was error correctable by reissue. See id. at 1358.

The Federal Circuit’s analysis began with the premise—equally applicable here—that “[t]he [reissue] statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.” *Id.* The court noted that the statute applies “to situations in which an error occurred—situations that include the patentee having claimed more or less than he had a right to claim in the patent.” *Id.* (internal quotations omitted). Because Doyle’s claims differed in scope from his issued claims, Doyle’s reissue application claims “come squarely within the mandate of section 251.” *Id.* Here, too,

reissue claims 13-82 clearly differ in scope from the originally issued claims. Thus, as a threshold matter, Applicant's reissue claims—like Doyle's—come squarely within the mandate of section 251.

The Board in *In re Doyle* (like the Examiner here) viewed Doyle's claims as precluded under the *In re Orita* doctrine, which provides that failure to pursue non-elected claims in a divisional application is not error correctable by reissue. The Federal Circuit rejected the Board's conclusion because "the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group." *Id.* at 1361. In short, *In re Orita* simply does not apply so long as the reissue claims are not "substantially similar" to the claims of the non-elected group(s). Here, the New Claims are decidedly not "substantially similar" to the claims of the non-elected groups. Indeed, the Examiner has not even contended that they are. Rather, as explained further below and as is evident from the claims themselves, reissue claims 13-82 are linking claims that include limitations from both the originally elected subject matter and the originally non-elected subject matter (and are therefore different in scope than the claims corresponding to either the originally elected subject matter or the originally non-elected subject matter).

Although the reissue claims in *In re Doyle* were genus claims, the Federal Circuit did not narrowly tailor its analysis to such broad claims. To the contrary, the Federal Circuit spoke more generally, rejecting outright the PTO's position—the same position the Examiner has adopted here—that acquiescence to a restriction requirement "forecloses the applicant's right to assert claims in reissue to any portion of the subject matter of the nonelected groups." *Id.* The court held that this was "too broad a view of *In re Orita*." *Id.* Here, as explained further below, Applicant's hybrid linking claims recite a "portion of the non-elected groups" in conjunction with a portion of the elected group. For the same reason as applied in *In re Doyle*, *In re Orita* does not apply here.

The *In re Doyle* court also found compelling another factor that is equally applicable here: like Doyle, Applicant "could have prosecuted his reissue claims with the claims of the elected group":

There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group. Indeed, as the Solicitor

concedes, these linking claims not only could have but *should have* been prosecuted with the elected group. This undercuts the other, more important rationale of *In re Orita*: that the issued patent contains no error. This second rationale underlying the result in *In re Orita* turned on the fact that the applicant could not have asserted the new reissue claims with the elected group. The reason, of course, was the restriction requirement-the examiner specifically required Orita to prosecute those claims in a different application. In contrast, Dr. Doyle could have prosecuted his claims with the elected group without running afoul of the restriction requirement because they are linking claims. See *Manual of Patent Examining Procedure* § 809.03 (8th ed. 2001) (“MPEP”).

Id. at 1360. As recognized by the *In re Doyle* court, an Applicant is always free to prosecute linking claims alongside the elected group.

The Examiner does not appear to disagree with this analysis. Instead, the Examiner states that the New Claims are not linking claims because, in the Examiner’s view, the originally elected and non-elected subject matter is mutually exclusive. Applicant respectfully disagrees and discusses this issue in Section C below.

B. *Ex Parte Okamoto* Is Relevant and Did Involve a Restriction Requirement In Okamoto’s Original Application.

The Examiner contends that *Ex Parte Yoshio Okamoto et al.*, Appeal No. 2000-0132 (available at 2006 WL 2523548) is irrelevant because the Examiner believes that no restriction requirement was entered in that case. Applicant respectfully disagrees. The Board’s opinion makes clear that there was a restriction and an “original election requirement”: “The claims presented in the instant reissue application are drawn to the combination of one of the nonelected species (from the original election requirement) together with a carrier in a chromatographic column.” See *id.* at *3 (emphasis added). Thus, Applicant respectfully asserts that there was a restriction requirement in *Okamoto*, just as one occurred in the present case.

Equally importantly, the reissue claims presented by Okamoto (like those presented by Applicant here) were not drawn to the non-elected subject matter. Instead, the reissue claims in *Okamoto* (as here) were drawn to subject matter different from the non-elected subject matter. Specifically, in the original application Okamoto never presented claims “drawn to a combination of a separating agent and a chromatographic column” in the original application (just as applicant here never presented the New Claims during the

original prosecution):

In the present case, no formal restriction requirement of claims drawn to a combination of a separating agent and a chromatographic column was ever imposed by the examiner, or acquiesced by the appellants, since they were not presented in the appellants' original application. Thus, it cannot be argued that the appellants' failure to file a divisional application to such subject matter was a deliberate act and not an error under Section 251.

Id. Stated slightly differently, the Board held that because Okamoto's reissue claims differed from the original non-elected subject matter, "it cannot be argued that the appellants' failure to file a divisional application to such subject matter was a deliberate act."

The same is true here. Applicant never filed the currently pending New Claims during the original prosecution. Consequently, the original examiner never restricted Applicant's current claims and Applicant therefore never filed a divisional application directed to them. Thus, as was the case in *Okamoto*, "it cannot be argued that the appellants' failure to file a divisional application to such subject matter was a deliberate act."

Applicant respectfully asserts that the Board's decision in *Ex Parte Okamoto* is controlling here and requires the withdrawal of the Examiner's rejection based on a purportedly defective reissue oath.

C. The Originally Elected and Non-Elected Subject Matter Was Not Mutually Exclusive and the New Claims Are Subcombination Claims that Link the Elected and Non-Elected Subject Matter.

The Examiner states that "[b]y failing to file a divisional application, Applicant lost his right to claim any subject matter other than the claimed invention as patented by electing the species of figures 2A, 2B, 3A, to 3C and 3F." See OA at 3. This statement is inconsistent with *In re Doyle*, a case in which the applicant did not file a divisional application but nevertheless was allowed to reissue claims broader than the originally elected invention. The Examiner apparently seeks to distinguish *In re Doyle* based on the belief that the originally elected species (*i.e.*, Figures 2A, 2B, 3A-3C and 3F) are "mutually exclusive" from the originally non-elected species (*i.e.*, Figures 3D, 3E, 4(A-C), 5(A-C), 6(A-C), 7(A-C), 8(A-C), 9(A-B), and 12(A-C)).

Applicant respectfully disagrees. Under the MPEP, species are only mutually exclusive if the species' claim limitations do not overlap:

Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first.

MPEP 806.04(f). Here, the elected and non-elected species all involve overlapping claim limitations. For example, both the elected and non-elected species utilize light emitting diodes (“LEDs”). *Compare for example* originally issued claim 9 (“The apparatus of claim 6 wherein the plurality of light sources are light emitting diodes.”) with non-elected claim 37 of the original application (“A lighting device for lighting a stage comprised of: a plurality of light sources; the plurality of light sources comprised of a plurality of continuous spectrum white LED’s ; wherein at least two of the plurality of continuous spectrum white LED’s are controlled individually for varying intensity.”).

The Examiner likewise contends that the elected and non-elected subject matter are “mutual exclusive” because the elected species are (Examiner believes) limited to a flashlight, whereas the non-elected species are not. Respectfully, Applicant disagrees. Specifically, originally issued independent claims 1, 6, 10, 11 and 12 are not limited to a flashlight, a term that appears nowhere in those claims. This is confirmed by dependent claim 5, which does recite a “flashlight” case. *See* originally issued claim 5 (“The apparatus of claim 1 and wherein the removable holder is in the form of a cover and the case is in the form of a flashlight case.”). The fact that dependent claim 5—but not the broader independent claims—includes this limitation confirms that the broader independent claims are not limited to a flashlight. *See AK Steel Corp. v. Sollac*, 344 F.3d 1234 (Fed. Cir. 2003) (“Under the doctrine of claim differentiation, dependent claims are presumed to be of narrower scope than the independent claims from which they depend.”).

The Examiner’s contention that the different species are mutually exclusive from one another is not only inconsistent with the claims but also with the patent specification, which provides:

This invention relates to improved methods and apparatus for using a plurality of light sources to illuminate an area or aperture. The invention discloses improvements to devices using a plurality of light sources where the plurality of light sources are multiple wavelengths and may be light emitting diodes (also called in this application “LEDs”). The inventions

contained within the text are directed at hand held flashlights, theatrical lighting, and may have other applications. Theatrical lighting is used in concerts, special events, nightclubs, television studios, restaurants and theme parks.

Col. 1:5-14 (emphasis added). Thus, the patent makes clear that the embodiments disclosed can be used not only in flashlights but also theatrical lighting and other applications. This statement reflects generally that circuitry (*e.g.*, lamp driver circuitry) can be used in combination with different embodiments and species. Further, the general statement is made specific later in the patent: “Each LED of the groups of LEDs shown in FIG. 3D are individually controllable by electronic circuitry which may be similar to that of FIG. 3F or with some other circuitry.” Col. 11:50-53.

Another example demonstrating the overlap between the elected and non-elected species relates to the use of a flexible substrate. The Examiner asserts that the originally elected species are directed to *inter alia* a “flexible substrate” and that this is “mutually exclusive” from the originally non-elected species that the Examiner concludes do not relate to a flexible substrate. Yet the patent explicitly provides that the species of non-elected Figure 5A (non-elected) may employ a flexible substrate:

The apparatus 610 in FIG. 5A operates by applying electrical current to the coil 655 through wires 673 and 674. When no current is applied to the coil 655 the flexible substrate 612 is in a natural resting position as shown in FIG. 5A. As direct current is applied to the coil 655 it will either push on the substrate 612 or pull on the substrate 612 depending on the polarity. This can be seen as particularly useful as high speed converging and diverging mechanisms can be created. (I.e. the light sources can converge and diverge from the center of the substrate 612 at a high rate of speed). Various other methods of using magnetic force could also be created along the same scope.

Col. 13:59-14:3 (emphasis added). The same is true for non-elected Figure 6A: “FIG. 6A illustrates an apparatus 710 comprised of a cam system driven by a stepper motor. Alternatively, motors, other than a stepper motor, can be used. Apparatus 710 is comprised of flexible substrate 712, housing 718, and a device 750.” Col. 14:16-20 (emphasis added). Thus, the elected and non-elected subject matter overlap with regards to whether they encompass the use of a flexible substrate.

Applicant respectfully contends that the elected and non-elected subject matter is not

mutually exclusive. Because this appears to be the Examiner's basis for challenging Applicant's assertion that the New Claims are linking claims and a proper basis for a reissue application, Applicant respectfully request that the Examiner withdraw his assertion that the reissue declaration is defective as well as his rejection of the claims on this basis.

D. The New Claims Are Adequately Supported by the Patent Specification and Satisfy the Written Description Requirement.

The examiner objects to the specification as failing to provide antecedent basis for the claimed subject matter. The examiner states that:

The descriptions of the specification, as referred to by Applicant of May 11, 2005 fail to provide support for the features claimed in the reissue claims. These descriptions as relied on by Applicant do not support that the invention of figure 3F (elected invention) can be used with the inventions of figure 3D (non elected invention) and 12C (non elected invention) as well as they do not support that the invention of figure 3D can be used with the invention of figure 12C."

Action at 5 (emphasis added). Applicant respectfully disagrees because the specification clearly indicates that the invention of figure 3F (elected invention) can be used with the invention of figure 3D (non elected invention):

"Each LED of the groups of LEDs shown in FIG. 3D are individually controllable by electronic circuitry which may be similar to that of FIG. 3F or with some other circuitry. For example, white LED 371d is individually controllable so that it can be turned on and off individually."

U.S. Patent no. 6,357,893 B1, col. 11, ll. 50-54.

Although Fig. 3F shows the control of two LEDs, such as 2312a and 2312p, by one discrete circuit (id. at col. 10, ll. 22-23), the description referring to Fig. 3F indicates that this can be modified to control one LED individually:

FIG. 3F shows two LEDs per circuit as an example however one LED per circuit or greater amounts than two LEDs per circuit may be controlled individually if the conductors on the substrate are so arranged.

Id. at col. 10, ll. 48-52.

One skilled in the art would recognize that electronic circuitry "similar to that of Fig. 3F" would include the circuitry as shown in Fig. 3F and circuitry in which one LED is provided per circuit, or more than two LEDs is provided per circuit. See Tam Bailey Declaration ("Decl.") ¶ 4. Further, one skilled in the art would also recognize that the

inventor is indicating that circuitry detailed in Fig. 3F and the related description can be used to control the LEDs of Fig. 3D. See Id. ¶ 5.

Although the Examiner clearly appreciates the above language from the patent specification, he nevertheless concludes that the specification does not teach that the LEDs of Figure 3D can be controlled by the circuitry of Figure 3F because the patent specification states that the Figure 3D LEDs can be controlled by circuitry that “may be similar” to that disclosed in Figure 3F. See Action at 3. Applicant respectfully submits that this position is not reasonable. The fact that the LEDs of Figure 3D can be controlled by circuitry that may be similar to that disclosed in Figure 3F necessarily suggested that the same circuitry may be used. See Id. ¶ 5-6.

Furthermore, the question under the written description requirement is not whether the “LED of figure 3D is controlled by the circuitry of figure 3F” but rather whether a person of ordinary skill reading the patent would conclude that the inventor possessed the concept of using the circuitry of Figure 3F with the LEDs of Figure 3D. Cite MPEP. A person of ordinary skill would so conclude. See Tam Bailey Decl. ¶ 7.

The present application also clearly indicates that the invention of figure 3D can be used with the invention of figure 12C:

The substrates 812 and 912, instead of the LED patterns shown, may have a different number of light sources or patterns and may incorporate embodiments like that shown in FIGS. 3D and 3E.

U.S. Patent No. 6,357,893 B1, col. 16, ll. 21-24.

“FIG. 12C shows electronic housing 960 and lamp housing 970. Electronic housing 960 includes processor 2266 (or control and communications board) and lamp driver circuit 2280. The lamp housing 970 includes fan 2270, motor 950, substrate 912, and variable filter 1913.” Id., col. 18, l. 66- col. 19, l. 4. One skilled in the art would thus easily recognize that the inventions of Figures 3F (including related description), 3D, and 12C can be used together. See Tam Bailey Decl. ¶ 9. Because the patent specification establishes that the embodiments of Figures 3D, 3F and 12C can be used together, Applicant respectfully disagrees with the Examiner’s conclusion that “the inventions of figures 3D, 3F, and 12C are mutually exclusive from one another.” See Action at 4.

The Examiner has rejected the New Claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully

disagrees with the Examiner. First, the examiner's written description rejections do not analyze each claim individually as required:

Each claim must be separately analyzed and given its broadest possible interpretation in light of and consistent with the written description.

MPEP 2163, IIA 1 (citing In re Morris, 127 F.3d 1048, at 1053-54 (Fed. Cir. 1997)).

Second, the rejections do not refer to specific limitations of specific claim numbers as required. Instead, the rejections refer to portions of the specification which were previously referred to regarding the objection to the specification. For example, the examiner again refers to the specification language "electronic circuitry which may be similar to that of figure 3F." See Action at 6. This is not a claim limitation. Moreover, as described above, one skilled in the art reading the entire patent application would recognize that "'electronic circuitry which may be similar to that of figure 3F" includes the circuitry of Figure 3F and related circuitry described with reference to Figure 3F, such as circuits having one LED or more than two LEDs per discrete circuit. See Tam Bailey Decl. ¶ 4. This latter point is key because the written description requirement is satisfied "[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." MPEP 2163.

Similarly, the examiner again refers to the language "may incorporate embodiments like that shown in figure 3D." See Action at 6. Again, this is not a claim limitation but rather a portion of the specification. The Examiner has not explained which claims, if any, do not pass muster under the written description requirement based on this alleged deficiency. Furthermore, Applicant contends that no deficiency exists. One skilled in the art reading the entire patent application would recognize that the language "may incorporate embodiments like that shown in figure 3D" reflects that the inventor was in possession of the concept of incorporating the embodiment of Figure 3D or similar embodiments. See Tam Bailey Decl. ¶ 11.

The Examiner concludes that:

The reissue claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventions of figures 3D, 3F and 12C can be used with respect to one another at the time the application was filed.

See Action at 6. Respectfully, the examiner is incorrect. For the reasons detailed above, one skilled in the art would recognize that the inventions of figures 3D, 3F, and 12C can be used with respect to one another and that the inventor has sufficiently disclosed such subject matter. See Tam Bailey Decl. ¶ 7-9. Furthermore, one skilled in the art would recognize that the circuitry disclosed and discussed with respect to Figure 3F, or related circuitry, can be used to control the LEDs of Figure 3D as well as the embodiment of Figure 12C in a multiparameter lighting apparatus. See Id. ¶ 7-9.

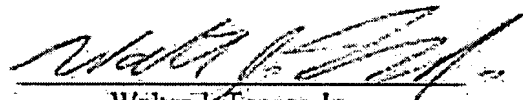
The rejections under 35 U.S.C. 112 are respectfully submitted to be incorrect and the claims are submitted to be allowable.

CONCLUSION

Applicant respectfully requests reconsideration of the pending reissue claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

Respectfully submitted,

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Dated



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